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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/507,436

01/25/2005

Juha Maijala

METSO-20

8543

36528 7590 09/26/2008

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EXAMINER

KRUER, KEVIN R

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

09/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/507,436	Applicant(s) MAIJALA ET AL.	
	Examiner KEVIN R. KRUER	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 08 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 8, 2008 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 20-43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification, while containing support for the endpoint of "1um" (0014) does not contain support for the claimed endpoint "greater than 1um."

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 20-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0982120A1 (herein referred to as Bando).

Bando teaches a method for coating a surface of a continuous paper or board web formed of papermaking fibers (FIG 3 and 0082), with a dry coating powder (abstract), the method comprising the steps of: moving the continuous paper or board web between electrodes which are at different electrical potentials (0104); applying the dry coating powder on to a first surface of the continuous paper or board web by utilizing the difference in the electric potential (0081). The dry coating powder may be formed by freeze-drying. (0043) and has an average particle size of 1-15 micrometers (0043). The polymeric binder material has a glass transition temperature of 20° C to about 100° C (0034) and has a moisture content of less than 15% (inherent). The dry coating powder is pre-charged (0104). At least one additional layer is formed on the first coated surface by a dry surface treatment process (abstract).

Bando teaches the coating may comprise up to 60wt% inorganic coloring filler (0041) and up to 50wt% filler with a particles size of 1-5um (0058-0059). Thus, it would have been obvious to make a dry coating powder comprising 70-99% inorganic material and 1-30% polymeric binder material in order to obtain a coating with the desired coloring and properties. Said coating is herein understood to be "homogeneous"

because the components of said coating are taught to be mixed together. Mixing is herein understood to imply homogenous compositions which will result in homogenous coatings.

Bando teaches a particle size range of 1nm to 1um, but does not teach particles meeting the claimed "greater than 1um" limitation. However, the courts have held that a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ773 (Fed. Cir. 1985). In the present applicant, the skilled artisan would have expected particles with diameters slightly greater than 1um to have the same properties as those having a particle size of 1um. While "fixability" concerns limit the upper range of the particle diameters taught in Bando, the skilled artisan would not expect a substantial difference in said property between particles with a diameter of 1um and those with a diameter "slightly greater than 1um." This position is supported by the fact that the coating already comprises particle with diameters greater than 1um (0058-0059) which demonstrates particles of said size are fixable.

Bando does not teach the continuous paper or board web is caused to travel at a speed of 1,200 to 2,500 m/min. However, it would have been obvious to the skilled artisan to vary the line speed of said paper to ensure quality control and productivity.

Bando does not teach simultaneously or sequentially applying a coating to both sides of the paper substrate. However, it would have been obvious to apply a coating to

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the backside of the paper substrate (either sequentially or simultaneously) in order to provide the substrate with image receiving capabilities on both sides thereof.

Bando does not teach passing the coating through a nip formed by a hot hard roll and a moving earthing member and subjecting the dry coating powder on the web to a temperature of 80-350°C, a linear nip load of 25-450 kN/m and a nip dwell time of 0.1-100 ms.. However, it would have been obvious to the skilled artisan to pass the coating of Bando through said nip in order to smooth the coating and obtain uniformity.

Response to Arguments

Applicant's arguments filed July 7, 2008 have been fully considered but they are moot in view of the new grounds of rejection.

Conclusion

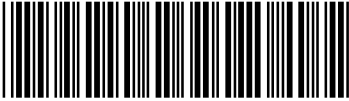
Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN R. KRUEER whose telephone number is (571)272-1510. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin R Kruer/
Primary Examiner, Art Unit 1794

<div>Application Number</div> <div></div>	Application/Control No.	Applicant(s)/Patent under Reexamination	
	10/507,436	MAIJALA ET AL.	
	Examiner	Art Unit	
	KEVIN R. KRUER	1794	